YKL ENGINEERING SDN BHD v. SUNGEI KAHANG PALM OIL SDN BHD & ANOR

FEDERAL COURT, PUTRAJAYA
ROHANA YUSUF PCA
AZAHAR MOHAMED CJ (MALAYA)
MOHD ZAWAWI SALLEH FCJ
[CIVIL APPEAL NO: 02(f)-9-02-2021(J)]
8 JULY 2022

Abstract – *(i) An invention that is not new by reason of the prior disclosure of the prototype/machine within the meaning and conditions of s. 14(2)(a) of the Patents Act 1983 will make a patent invalid; (ii) Failure to prove elements of sufficient objective similarity and causal connection between two works would cause a claimant not to succeed in a claim on infringement of copyright, although copyright may subsist in its design drawings.*

INTELLECTUAL PROPERTY: *Patent – Infringement – Allegation of – Raising issue of anticipation by prior art to dispute novelty of patent – Whether ought to be pleaded with specific particulars of prior art relied upon to defeat registered patent – Whether s. 14(2)(a) of Patents Act 1983 on public disclosure of prior art apply where there was unauthorised disclosure to third party of prototype of machine – Whether patent invalidated on ground of anticipation pursuant to s. 14(2)(a) where there is unauthorised disclosure of prototype machine installed on private property for experimentation – Invention not new by reason of prior disclosure of prototype/machine within meaning and conditions of s. 14(2)(a) – Whether patent invalid*

INTELLECTUAL PROPERTY: *Copyright – Subsistence of – Whether copyright could still subsist and not be negated by existence of earlier prior arts – Whether there were substantive efforts made to entitle itself to subsistence of copyright in design drawings – Basic test required under s. 7(3) of Copyright Act 1987 – Whether met – Whether design drawings independently eligible for copyright protection under s. 7(2), (2A) & (4) – Whether infringement of copyright established*

The appellant was in the business of designing and manufacturing specialised machinery and equipment for palm oil processing. The appellant's claims revolved around its Malaysian Patent No. MY139512-A, relating to a machine used in the oil palm industry, the 'Fruit Bunch Splitter' ('appellant's patent') and the design drawings relating to the Fruit Bunch Splitter and its component parts ('design drawings'). The first respondent was in the business of operating a palm oil factory, including processing fresh fruit bunches ('FFB') of palm oil while the second respondent was in the business of manufacturing, servicing and trouble-shooting technical and other related issues concerning machineries in plant construction for palm oil mills, wood and pulp processing and industrial plants. The appellant approached the first

A respondent to showcase its Fruit Bunch Splitter at the first respondent's premises for test run purposes and to conduct a demonstration with a view to a sale. The appellant provided a quotation for the sale of the Fruit Bunch Splitter. The sale was, however, not concluded despite numerous follow-ups by the appellant. The dispute between the parties arose when the appellant
B received information that the first respondent had been operating two units of oil palm fruit bunch splitters in its factory which closely resembled its Fruit Bunch Splitter. Upon visiting the first respondent's premises, the appellant found that the first respondent had installed two units of oil palm fruit bunch splitters. The first respondent had purchased the two units from
C the second respondent ('SK Machines'). The appellant claimed that both the SK Machines were made in accordance with the invention disclosed and claimed in the specifications of the appellant's patent. Subsequently, the appellant sued both the respondents for infringement of its patent and copyright in respect of the manufacturing and the use of the SK Machines.
D In substance, the appellant's case was that the second respondent infringed the appellant's patent by manufacturing and selling two units of the SK Machines to the first respondent and that the first respondent had infringed the appellant's patent by using the SK Machines. The respondents denied the allegations of patent infringement and counterclaimed to invalidate the patent for (i) lack of novelty, by virtue of the prior art which was disclosed to the
E public prior to the filing date of the appellant's patent (12 January 2006); and (ii) obviousness, as having regard to the prior art and common general knowledge, the invention which was the subject matter of the appellant's patent did not involve an inventive step. The prior art which was specifically pleaded by the respondents, among others, were (i) drawings of the Kim
F Loong Machine ('Kim Loong drawing') created on 1 August 2003; and (ii) a machine comprising the same features located and operating at Keng Seck Berhad in 2002 ('prototype/machine at Kek Seng'). The High Court found in favour of the appellant and concluded that the respondents had infringed the appellant's patent and the respondents' counterclaims were
G dismissed. In considering the issue of novelty, the High Court rejected the evidence relating to the Desa Kim Loong Machine as a prior art as it was not a pleaded prior art and could not be legally admitted for consideration as one of the prior arts to challenge the validity of the appellant's patent. On the issue of lack of inventive step, the High Court made a finding that the
H appellant's patent was inventive and not obvious to persons skilled in the art at the material time. The Court of Appeal, however, allowed the respondents' appeal and set aside the whole of the High Court's decision and the respondents' counterclaims were allowed. Principally, the Court of Appeal found that the appellant's patent was invalid on the ground of anticipation by prior art due to the existence of the Desa Kim Loong
I Machine (which was not pleaded) and the prototype/machine at Keck Seng. On the issue of inventive step, the Court of Appeal found as a fact that the purported inventive concept was obvious to the normally skilled but unimaginative addressee in the art at the priority date to whom had been

imputed the common general knowledge in the relevant art. This court granted leave to the appellant against the decision of the Court of Appeal on the following questions of law (i) where a defendant invoked s. 14(2)(a) of the Patents Act 1983 ('the Act') to raise the issue of anticipation by prior art to dispute the novelty of the plaintiff's patent, whether the defendant was obliged by law to plead with specificity the particulars of prior art relied upon by him to defeat the registered patent ('question 1'); (ii) in a patent trial where anticipation was raised to challenge the validity of a patent, whether a defendant should be allowed to rely on prior art documents and/or prior use which were not specifically pleaded in its attempt to invalidate the patent ('question 2'); (iii) whether a patent appeal had miscarried where the appellate court had disregarded a prior decision of the appeal court itself in the same case to disallow reliance on an item of alleged prior art which the High Court had loyally followed subsequently by disregarding the said item in arriving at its decision ('question 3'); (iv) could s. 14(2)(a) of the Act on public disclosure of a prior art apply where there has been an unauthorised disclosure to a third party of the prototype of the machine invented by the plaintiff ('question 4'); (v) whether a defendant could invalidate a patent on the ground of anticipation pursuant to s. 14(2)(a) of the Act where it was a case of an unauthorised disclosure of the plaintiff's prototype machine installed on a private property for experimentation by the plaintiff ('question 5'); (vi) if claim 1 of a patent was declared to be invalid, was there a legal duty for the court to examine each and every dependent claim and decide individually whether the dependent claim was valid and thereafter to decide whether any of the dependent claims had been infringed ('question 6'); and (vii) having regard to the concept of originality in copyright law which was distinct from the concept of novelty in patent law, whether the design drawings of an article (the work) would independently be eligible for copyright protection under s. 7(2), (2A) and (4) of the Copyright Act 1987 ('CA') as artistic works ('question 7').

Held (dismissing appeal)
Per Azahar Mohamed CJ (Malaya):

(1) In a case where a party claims that a patent is not a patentable invention as it is not new and does not involve any inventive step, the parties' expert is required to provide their opinion on the relevant prior art to assist the court on the issues of invalidation of the patent. Validity of the patent must be assessed by the court with the aid of an expert often referred to as a 'person having ordinary skill in the art.' The Court of Appeal failed to appreciate that this was a patent case and that the respondents were relying on items of prior art with the object of invalidating the appellant's patent. The importance of giving notice to the appellant by the respondents, in respect of the Desa Kim Loong Machine and of specific pleading by the respondents seeking to invalidate the appellant's patent, could never be overemphasised. (paras 36 & 37)

(2) A party attacking the validity of a patent should particularise the prior art in question in the pleading so that the parties and their experts may come to trial prepared to meet the case, which was intended to be proved against them, and that there may be no taking by surprise. In the present case, neither the appellant nor its experts were afforded the opportunity to scrutinise the Desa Kim Loong Machine in great detail and to submit their written opinions/reports on the same, as was the case in every patent trial. The respondents' introduction of the non-pleaded Desa Kim Loong Machine at the eleventh hour and the Court of Appeal's decision to admit the same into evidence had handicapped the appellant in its defence of their patent's validity. The Court of Appeal's decision in admitting the Desa Kim Loong Machine and invalidating the appellant's patent based on the same had clearly prejudiced and caused injustice to the appellant. It is a requirement in law on the part of a party to plead with specificity the particulars of prior art a party intends to rely on to invalidate a patent for lack of novelty or otherwise. Therefore, questions 1 and 2 were answered in the affirmative and in the appellant's favour. (paras 37, 41 & 42)

(3) Since there was no appeal to the Federal Court against the earlier dismissal of the respondents' amendment application, the decisions of the High Court and the earlier Court of Appeal pertaining to the treatment of the non-pleaded Desa Kim Loong Machine was final and could not be re-opened by the present Court of Appeal at a later stage during the appeal proper. By disregarding its previous decision on the same issue (which ought to be treated as final and binding upon the parties) and allowing the Desa Kim Loong Machine to be admitted, the Court of Appeal had contravened the principle of *res judicata*. Question 3 must be answered in the affirmative. (paras 49-51)

(4) An invention could only be validly treated as a patentable invention if it is new or novel and has never been disclosed to the public in the sense set out in s. 14(2)(a) of the Act. In the case of a prototype, if the prototype has been made available to at least one member of the public who is free in law and equity to examine it and/or disclose the information, that prototype has been 'disclosed to the public.' If it was, however, disclosed under an obligation of confidence, it had not been disclosed to the public. The Court of Appeal correctly held that there was sufficient evidence to establish that the prototype/machine at Keck Seng had been disclosed within the meaning of s. 14(2)(a) of the Act. On the facts, the disclosure of the prototype/machine at Keck Seng whilst on the third-party private premises were clearly not unauthorised. The prototype/machine at Keck Seng was incorporated into and formed part of the whole process or mill operations at Keck Seng's premises. DW2 was lawfully on the premises and had easy unrestricted access to the prototype/machine at Keck Seng. There were no security measures or

evidence of restrictions to access the same. DW2 was free in law and equity to examine and use the information disclosed by the prototype/machine at Keck Seng. (paras 61, 64 & 65)

(5) The disclosure in the prior art must be an enabling disclosure to anticipate the claimed invention. For there to be anticipation, there must be enabling disclosure. A prior art is deemed to have anticipated a patented invention if there is sufficient information conveyed to the public that would enable anyone who is in receipt of the information to be able to reproduce or duplicate the patented invention. There were no plausible reasons to interfere with the findings of the Court of Appeal that the disclosure was an enabling disclosure. It was unnecessary to answer both questions 4 and 5. (paras 66-70)

(6) Question 6 essentially addressed whether the court must examine each and every dependent claim and, thereafter, decide individually if the claim was valid and infringed. The Court of Appeal had examined each dependant claim individually prior to coming to the decision that the dependent claims were invalid. It was thus unnecessary to answer question 6. (paras 71, 76 & 77)

(7) The invention, which was the subject of the appellant's patent, was not new by reason of the prior disclosure of the Prototype/Machine at Keck Seng within the meaning and conditions of s. 14(2)(a) of the Act, and therefore the appellant's patent was invalid. The appellant's appeal relating to the appellant's patent was therefore dismissed. (paras 78 & 79)

Per Rohana Yusuf PCA:

(1) For copyright to subsist, the work must be (i) original; (ii) complies with the requirement as to form; (iii) belongs to one of the categories of protected works; and (iv) complies with the qualifications for copyright. Once these requirements are fulfilled, a work is protected irrespective of quality and the purpose for which it was created. The concept of 'newness' or 'novelty' in the patent law is not a relevant consideration for copyright to subsist. What is more important is that sufficient efforts have been expended to render the work original in copyright law as clearly articulated in s. 7(3)(a) of CA. Even if the earlier prior arts, particularly the prototype or Desa Kim Loong Machine were already in existence before the appellant's design drawings, the appellant's copyright would still subsist and would not be negated by the existence of the earlier prior arts as provided under s. 7(4) of the CA. (paras 101, 103 & 104)

(2) The legal proposition is clear that a work shall not be ineligible for copyright merely by reason that the making of the work involves an infringement of copyright in some earlier or other works. What is

A essential for a subsistence of copyright in such work is the sufficient effort expended in terms of time, labour, and skills to render the same original. The basic test required under s. 7(3)(a) of the CA had been met by the appellant. There were substantive efforts made by the appellant to entitle itself to the subsistence of copyright in the appellant's design B drawings. Thus question 7 should be answered in the affirmative. (paras 106, 108, 110 & 111)

(3) Infringement of copyright in this appeal was consequential to this court's finding that copyright subsisted in the appellant's design drawings. Even though the question of law posed did not relate to infringement of C copyright, the issue of infringement was a substantial merit to be dealt along with finding on the copyright subsistence as the copyrighted work is protected from any substantial reproduction or infringement under s. 13(1). (paras 112 & 113)

D **(4)** For purposes of direct infringement, it must be established that: (i) there is sufficient objective similarity between the original work or a substantial part thereof, and the infringing copy; (ii) there is a causal connection between the original work and the infringing copy, that is, the infringing copy must have been copied from the original work, whether directly or indirectly; and (iii) what had been infringed must E constitute a substantial part of the original work. In this case, even if there was access to the design drawings as alleged, the quotation sent to the first respondent was 22 April 2009. There was no explanation if indeed the technical drawing sent in 2009 was the same technical drawings of 2004 that formed the basis of the appellant's pleaded case. F It also did not help the appellant's case when DW2 testified that the SK Machines were adapted from the Kim Loong Drawing which was created in 2003. The need to prove causal connection between the two works were indispensable as copyright work must be shown to be a *causa sine qua non* of the infringing work. (paras 128, 134 & 135)

G **(5)** To succeed on a claim on infringement, the appellant bore the burden of proving the elements of sufficient objective similarity and causal connection between the two works. The burden was always on the appellant to establish those ingredients by evidence, only then it would give rise to an inference that the respondent had copied the appellant's H work. The burden on the respondents then was to rebut that inference. The appellant herein failed to establish all these three elements cumulatively to succeed on its claim of infringement. The appellant failed to establish that the respondents in fact had access to the appellant's design drawings. The appellant failed to establish any I infringement of the copyright. Though copyright subsisted in the design drawings of the appellant, but no infringement of copyright had been established. Thus, the appellant's appeal on the claim relating to copyright was also dismissed. (paras 136-139)

Bahasa Melayu *Headnotes*

Perayu menjalankan perniagaan mereka dan mengeluarkan mesin dan peralatan khusus untuk pemprosesan minyak sawit. Tuntutan perayu berkisar pada Paten Malaysia No. MY139512-A yang berkaitan dengan mesin yang digunakan dalam industri kelapa sawit, iaitu, 'Fruit Bunch Splitter' ('paten perayu') dan gambar reka bentuk yang berkaitan dengan Fruit Bunch Splitter dan bahagian komponennya ('lukisan reka bentuk'). Responden pertama menjalankan perniagaan mengendalikan kilang minyak sawit termasuk memproses minyak sawit tandan buah segar ('FFB') sementara responden kedua menjalankan perniagaan pembuatan, servis dan menyelesai masalah teknikal dan lain-lain yang berkaitan dengan mesin dalam pembinaan kilang untuk kilang kelapa sawit, pemprosesan kayu dan pulpa dan loji industri. Perayu menghubungi responden pertama untuk mempamerkan Fruit Bunch Splitter di premis responden pertama untuk tujuan ujian dan melakukan demonstrasi dengan tujuan jualan. Perayu memberikan sebut harga untuk jualan Fruit Bunch Splitter. Jualan itu, walaubagaimanapun, tidak dapat diselesaikan walaupun terdapat banyak tindakan lanjut oleh perayu. Perselisihan antara kedua-dua pihak timbul apabila perayu menerima maklumat bahawa responden pertama telah mengoperasikan dua unit pemisah kelapa sawit di kilangnya yang menyerupai Fruit Bunch Splitter perayu. Semasa melawat premis responden pertama, perayu mendapati bahawa responden pertama telah memasang dua unit pemisah buah kelapa sawit. Responden pertama membeli dua unit daripada responden kedua ('Mesin SK'). Perayu mendakwa bahawa kedua-dua Mesin SK dibuat selari dengan yang dinyatakan dan dituntut dalam spesifikasi paten perayu. Perayu kemudian menyaman kedua-dua responden kerana melanggar hak paten dan hak cipta berkenaan dengan pembuatan dan penggunaan Mesin SK. Hakikatnya, kes perayu adalah bahawa responden kedua melanggar hak paten perayu dengan membuat dan menjual dua unit Mesin SK kepada responden pertama dan bahawa responden pertama telah melanggar hak paten perayu dengan menggunakan Mesin SK. Responden menafikan tuduhan pelanggaran paten dan menuntut untuk membatalkan paten kerana (i) ketiadaan kebaharuan, berdasarkan rekaan terdahulu yang telah didedahkan kepada umum sebelum tarikh pemfailan paten perayu (12 Januari 2006); dan (ii) secara jelasnya, berdasarkan rekaan terdahulu dan pengetahuan umum, reka cipta yang menjadi perkara pokok hak paten perayu tidak melibatkan langkah inventif. Rekaan terdahulu yang secara khusus diplidkan oleh responden, antara lain adalah (i) lukisan Mesin Kim Loong ('lukisan Kim Loong') yang dibuat pada 1 Ogos 2003; dan (ii) mesin yang terdiri daripada ciri yang sama yang terletak dan beroperasi di Keng Seck Berhad pada 2002 ('prototaip/mesin Kek Seng'). Mahkamah Tinggi memutuskan memihak pada perayu dan menyimpulkan bahawa responden telah melanggar hak paten perayu dan tuntutan balas responden ditolak. Dalam mempertimbangkan isu kebaharuan, Mahkamah Tinggi menolak keterangan yang berkaitan dengan Mesin Desa Kim Loong sebagai rekaan

terdahulu kerana ini bukan rekaan terdahulu yang diplidkan dan tidak dapat diterima secara sah untuk dipertimbangkan sebagai satu rekaan terdahulu untuk mencabar kesahihan paten perayu. Berkenaan masalah kekurangan langkah inventif, Mahkamah Tinggi membuat keputusan bahawa paten perayu adalah inventif dan tidak jelas bagi orang yang mahir dalam rekaan pada waktu material. Mahkamah Rayuan, walaubagaimanapun, membenarkan rayuan responden dan mengetepikan keseluruhan keputusan Mahkamah Tinggi manakala tuntutan-tuntutan balas responden dibenarkan. Secara prinsip, Mahkamah Rayuan mendapati bahawa paten perayu tidak sah atas alasan jangkaan oleh rekaan terdahulu kerana adanya Mesin Desa Kim Loong (yang tidak diplidkan) dan Prototaip/Mesin Keck Seng. Berkenaan isu langkah inventif, Mahkamah Rayuan mendapati bahawa konsep inventif yang dimaksudkan jelas bagi penerima yang biasanya mahir tetapi tidak imaginitif dalam rekaan itu pada tarikh keutamaan kepada sesiapa yang telah dianggap mempunyai pengetahuan umum dalam rekaan yang berkaitan. Mahkamah ini memberi kebenaran kepada perayu merayu terhadap keputusan Mahkamah Rayuan atas soalan-soalan undang-undang berikut (i) apabila defendan menggunapakai s. 14(2)(a) Akta Paten 1983 ('Akta') untuk membangkitkan isu jangkaan oleh rekaan terdahulu untuk mempertikaikan kebaharuan paten plaintif, adakah defendan diwajibkan oleh undang-undang untuk memplid dengan khusus butir-butir rekaan terdahulu yang disandar olehnya untuk mematahkan paten berdaftar ('Soalan 1'); (ii) dalam perbicaraan paten apabila jangkaan ditimbulkan untuk mencabar kesahihan paten, sama ada defendan harus dibenarkan bergantung pada dokumen rekaan sebelumnya dan/atau penggunaan sebelumnya yang tidak secara khusus diplidkan dalam perbicaraan membatalkan paten ('Soalan 2'); (iii) sama ada rayuan paten telah salah arah apabila mahkamah rayuan mengabaikan keputusan sebelumnya dari Mahkamah Rayuan itu sendiri dalam kes yang sama untuk tidak membenarkan pergantungan pada item rekaan terdahulu yang kemudiannya diikuti oleh Mahkamah Tinggi yang mengabaikan perkara tersebut ketika mencapai keputusannya ('Soalan 3'); (iv) adakah s. 14(2)(a) Akta tentang pendedahan awam rekaan terdahulu terpakai sekiranya terdapat pendedahan yang tidak dibenarkan kepada pihak ketiga tentang prototaip mesin yang dicipta oleh plaintif ('Soalan 4'); (v) adakah defendan boleh membatalkan hak paten atas alasan jangkaan menurut s. 14 (2)(a) Akta di mana adalah kes pendedahan yang tidak dibenarkan tentang mesin prototaip plaintif yang dipasang pada harta tanah persendirian untuk eksperimen oleh plaintif ('Soalan 5'); (vi) jika tuntutan 1 paten dinyatakan tidak sah, adakah terdapat kewajipan undang-undang untuk memeriksa setiap tuntutan bergantung dan memutuskan secara individu sama ada tuntutan bergantung itu sah dan selepas itu untuk memutuskan sama ada mana-mana tuntutan bergantung telah dilanggar ('Soalan 6'); dan (vii) dengan mempertimbangkan konsep keaslian dalam undang-undang hak cipta yang berbeza membentuk konsep kebaharuan dalam undang-undang paten, sama

ada gambar reka bentuk artikel (karya) secara bebas layak mendapat perlindungan hak cipta bawah s. 7(2), (2A) dan (4) Akta Hak Cipta 1987 ('AHC') sebagai karya-karya rekaan.

Diputuskan (menolak rayuan)
Oleh Azahar Mohamed HB (Malaya):

(1) Dalam kes satu pihak mendakwa bahawa paten bukanlah reka cipta yang boleh dipatenkan kerana bukan perkara baharu dan tidak melibatkan langkah inventif, pakar pihak itu diminta memberikan pendapat mereka tentang rekaan terdahulu yang relevan untuk membantu mahkamah tentang isu-isu pembatalan hak paten. Kesahan paten mesti dinilai oleh mahkamah dengan bantuan pakar yang sering disebut sebagai 'orang yang mempunyai kemahiran biasa dalam rekaan.' Mahkamah Rayuan gagal mempertimbangkan bahawa ini adalah kes paten dan bahawa responden bergantung pada item rekaan terdahulu dengan tujuan membatalkan paten perayu. Pentingnya memberi notis kepada perayu oleh responden, berkenaan dengan Mesin Desa Kim Loong dan permohonan khusus oleh responden yang ingin membatalkan hak paten, perayu perlu dipertekankan.

(2) Pihak yang menyangkal kesahihan hak paten harus memperihalkan rekaan terdahulu yang dimaksudkan dalam permohonan agar pihak dan pakar mereka dapat hadir ke perbicaraan penuh bersiap sedia menangani kes tersebut untuk dibuktikan terhadap mereka, dan mungkin tidak akan ada kejutan. Dalam kes ini, perayu atau pakar-pakarnya tidak diberi kesempatan meneliti Mesin Desa Kim Loong secara terperinci dan mengemukakan pendapat/laporan bertulis mereka tentang hal yang sama, seperti yang berlaku dalam setiap perbicaraan paten. Responden telah mengemukakan Mesin Desa Kim Loong yang tidak diplidkan pada saat akhir dan keputusan Mahkamah Rayuan untuk menerima masuk perkara yang sama sebagai bukti telah melumpuhkan pembelaan kesahan paten perayu. Keputusan Mahkamah Rayuan dalam menerima masuk Mesin Desa Kim Loong dan membatalkan paten perayu berdasarkan perkara yang sama jelas memprejudiskan dan menyebabkan ketidakadilan pada perayu. Menjadi syarat dalam undang-undang untuk satu pihak untuk memplidkan dengan spesifik butir-butir rekaan terdahulu yang ingin disandar oleh pihak untuk membatalkan hak paten kerana ketiadaan kebaharuan atau sebaliknya. Oleh itu, soalan 1 dan 2 dijawab secara afirmatif dan memihak pada perayu.

(3) Oleh kerana tiada rayuan ke Mahkamah Persekutuan terhadap penolakan terdahulu permohonan pindaan responden, keputusan Mahkamah Tinggi dan Mahkamah Rayuan yang terdahulu berkaitan dengan keputusan berkenaan Mesin Desa Kim Loong yang tidak diplidkan adalah muktamad dan tidak dapat dibuka semula di Mahkamah Rayuan ini pada tahap selanjutnya semasa rayuan. Dengan

A mengabaikan keputusan terdahulu tentang isu yang sama (yang seharusnya dianggap sebagai muktamad dan mengikat pihak-pihak) dan membiarkan Mesin Desa Kim Loong diterima masuk, Mahkamah Rayuan telah melanggar prinsip *res judicata.* Soalan 3 harus dijawab secara afirmatif.

B **(4)** Satu reka cipta hanya boleh dianggap sebagai reka cipta yang dapat dipatenkan jika baharu dan tidak pernah didedahkan kepada umum dalam erti yang dinyatakan dalam s. 14(2)(a) Akta. Sekiranya berlaku prototaip, jika prototaip telah disediakan untuk sekurang-kurangnya seorang anggota masyarakat yang bebas dalam undang-undang dan ekuiti
C untuk memeriksanya dan/atau mendedahkan maklumatnya, prototaip itu telah 'didedahkan kepada umum.' Namun, jika hal itu didedahkan bawah kewajipan kepercayaan, hal itu belum didedahkan kepada umum. Mahkamah Rayuan dengan tepat menyatakan bahawa ada bukti yang cukup untuk membuktikan bahawa Prototaip/Mesin Keck Seng telah
D didedahkan dalam erti s. 14(2)(a) Akta. Berdasarkan fakta, pendedahan Prototaip/Mesin Keck Seng semasa berada di premis swasta pihak ketiga jelas bukan tidak dibenarkan. Prototaip/Mesin Keck Seng dimasukkan ke dalam dan menjadi sebahagian daripada keseluruhan proses atau operasi kilang di premis Keck Seng. DW2 berada di premis
E secara sah dan mempunyai akses mudah ke Prototaip/Mesin Keck Seng. Tiada langkah keselamatan atau bukti sekatan untuk mengaksesnya. DW2 bebas bawah undang-undang dan ekuiti untuk memeriksa dan menggunakan maklumat yang didedahkan oleh Prototaip/Mesin Keck Seng.

F **(5)** Pendedahan dalam rekaan terdahulu mestilah pendedahan yang membolehkan untuk menjangkakan reka cipta yang dituntut. Agar wujudnya anggapan, mesti ada pendedahan yang membolehkan. Rekaan terdahulu dianggap telah menjangkakan reka cipta yang dipatenkan jika terdapat maklumat yang cukup disampaikan kepada orang ramai yang
G akan membolehkan sesiapa yang menerima maklumat dapat menghasilkan semula atau menduplikasi reka cipta yang dipatenkan. Tiada alasan yang masuk akal untuk mengganggu keputusan Mahkamah Rayuan bahawa pendedahan itu merupakan pendedahan yang membolehkan. Oleh itu, tiada keperluan untuk menjawab kedua-dua Soalan 4 dan 5.

H **(6)** Soalan 6 pada dasarnya menangani sama ada mahkamah mesti memeriksa setiap tuntutan tanggungan dan selepas itu memutuskan secara individu jika tuntutan itu sah dan dilanggar. Mahkamah Rayuan telah memeriksa setiap tuntutan bergantung secara individu sebelum
I membuat keputusan bahawa tuntutan tanggungan itu tidak sah. Oleh itu, adalah tidak perlu untuk menjawab soalan 6.

(7) Reka cipta yang menjadi subjek paten perayu bukanlah perkara baharu kerana pendedahan sebelumnya mengenai Prototaip/Mesin Keck Seng dalam makna dan syarat s. 14(2)(a) Akta, dan oleh itu paten perayu tidak sah. Oleh itu, rayuan perayu yang berkaitan dengan paten perayu ditolak.

Oleh Rohana Yusuf PMR:

(1) Agar hak cipta wujud, karya mestilah (i) asli; (ii) mematuhi syarat dari segi bentuk; (iii) tergolong dalam salah satu kategori karya yang dilindungi; dan (iv) mematuhi kelayakan hak cipta. Setelah syarat ini dipenuhi, karya dilindungi tanpa mengira kualiti dan tujuannya dibuat. Konsep 'newness' atau 'novelty' dalam undang-undang paten bukanlah pertimbangan yang relevan untuk hak cipta wujud. Yang lebih penting adalah bahawa usaha yang cukup telah diambil untuk menjadikan karya itu asli dalam undang-undang hak cipta seperti yang dinyatakan dengan jelas bawah s. 7(3)(a) AHC. Walaupun rekaan terdahulu, terutama Prototaip atau Mesin Desa Kim Loong sudah ada sebelum lukisan reka bentuk perayu, hak cipta perayu masih akan wujud dan tidak akan ditolak dengan adanya rekaan terdahulu yang diperuntukkan bawah s. 7(4) AHC.

(2) Saranan undang-undang jelas bahawa karya tidak akan menjadi tidak layak untuk hak cipta hanya dengan alasan bahawa pembuatan karya tersebut melibatkan pelanggaran hak cipta dalam beberapa karya sebelumnya atau karya lain. Apa yang penting untuk adanya hak cipta dalam pekerjaan tersebut adalah upaya yang cukup yang diusahakan dari segi waktu, tenaga kerja, dan kemahiran untuk menghasilkan sesuatu yang asli. Ujian asas yang diperlukan bawah s. 7(3)(a) AHC telah dipenuhi oleh perayu. Terdapat usaha-usaha substansial yang dilakukan oleh perayu untuk memberi hak kepadanya untuk kewujudan hak cipta dalam gambar reka bentuk perayu. Oleh itu, Soalan 7 harus dijawab secara afirmatif

(3) Pelanggaran hak cipta dalam rayuan ini berbangkit daripada dapatan-dapatan mahkamah ini bahawa hak cipta wujud dalam gambar reka bentuk perayu. Walaupun persoalan undang-undang yang dikemukakan tidak berkaitan dengan pelanggaran hak cipta, isu pelanggaran adalah merit yang ketara yang harus ditangani bersama dengan dapatan tentang hak cipta kerana karya hak cipta dilindungi dari sebarang keluaran semula atau pelanggaran yang besar bawah s. 13(1).

(4) Untuk tujuan pelanggaran langsung, mesti dibuktikan bahawa: (i) terdapat persamaan objektif yang mencukupi antara karya asal atau sebahagian besar daripadanya, dan salinan yang melanggar; (ii) terdapat hubungan kausa antara karya asal dan salinan yang melanggar, iaitu salinan yang melanggar mestilah ditiru daripada karya asal, sama ada secara langsung atau tidak langsung; dan (iii) apa yang telah dilanggar

mestilah sebahagian besar daripada karya asal. Dalam kes ini, walaupun terdapat akses pada lukisan reka bentuk seperti yang didakwa, sebut harga yang dihantar kepada responden pertama adalah pada 22 April 2009. Tiada penjelasan sekiranya lukisan teknikal yang dihantar pada tahun 2009 adalah lukisan teknikal yang sama pada tahun 2004 yang membentuk asas kes yang diplidkan perayu. Juga tidak membantu kes perayu apabila DW2 memberi keterangan bahawa Mesin SK diadaptasi daripada Lukisan Kim Loong yang dicipta pada tahun 2003. Keperluan untuk membuktikan hubungan kausa antara kedua-dua karya itu amat diperlukan kerana karya hak cipta mesti ditunjukkan sebagai *causa sine qua non* karya yang melanggar.

(5) Untuk berjaya dalam tuntutan pelanggaran, perayu menanggung beban membuktikan unsur-unsur kesamaan objektif dan hubungan kausa yang mencukupi antara kedua-dua karya tersebut. Beban selalu pada perayu untuk menetapkan bahan-bahan tersebut dengan bukti, hanya dengan itu akan menimbulkan kesimpulan bahawa responden telah meniru karya perayu. Beban responden ketika itu adalah untuk menolak kesimpulan itu. Perayu gagal membuktikan ketiga-tiga elemen ini secara kumulatif untuk berjaya atas tuntutan pelanggarannya. Perayu gagal membuktikan bahawa responden sebenarnya mempunyai akses pada gambar reka bentuk perayu. Perayu gagal membuktikan pelanggaran hak cipta. Meskipun hak cipta wujud dalam lukisan-lukisan reka bentuk perayu, tetapi tidak ada pelanggaran hak cipta dibuktikan. Oleh itu, rayuan perayu berkaitan tuntutan yang berkaitan dengan hak cipta juga ditolak.

Case(s) referred to:

Alsop Flour Process Ld v. Flour Oxidizing Company Ld [1908] 25 RPC 477 ***(refd)***
B Braun Melsungen AG & Anor v. Terumo Kabushiki Kaisha & Anor [2011] 1 LNS 947 ***(refd)***
Bristol-Meyer Co's Application [1969] RPC 146 ***(refd)***
Bruce v. Odhams Press Ltd [1936] 1 All ER 287 ***(refd)***
CIMB Bank Bhd v. Sebang Gemilang Sdn Bhd & Anor [2015] 7 CLJ 870 CA ***(refd)***
Cylinders Ptv Ltd v. Marks (1996) 144 ALR 627 ***(refd)***
Dura-Mine Sdn Bhd v. Elster Metering Ltd & Anor [2015] 1 CLJ 887 FC ***(refd)***
Elster Metering Limited & Anor v. Damini Corporation Sdn Bhd & Anor [2012] 1 LNS 959 CA ***(refd)***
Folding Attic Stairs Limited v. The Loft Stairs Company Limited & Anor [2009] EWHC 1221 ***(refd)***
Francis Day & Hunter Ltd And Another v. Bron And Another [1963] Ch 587 ***(refd)***
Generics (UK Ltd And Others v. H Lundbeck A/S [2009] All ER 963 ***(refd)***
Government Of Malaysia v. Dato Chong Kok Lim [1973] 1 LNS 35 HC ***(refd)***
Hartecon JV Sdn Bhd & Anor v. Hartela Contractors Ltd [1997] 2 CLJ 104 CA ***(refd)***
Ho Tack Sien & Ors v. Rotta Research Laboratorium S.p.A & Anor; Registrar Of Trade Marks (Intervener) & Another Appeal [2015] 4 CLJ 20 FC ***(refd)***
Holliday v. Heppenstall [1889] 6 RPC 320 ***(refd)***
Kirin-Amgen Inc v. Hoechst Marion Roussel Ltd [2005] 1 All ER 667 ***(refd)***
Lau Foo Sun v. Government Of Malaysia [1969] 1 LNS 78 FC ***(refd)***

Longman Malaysia Sdn Bhd v. Pustaka Delta Pelajaran Sdn Bhd [1986] 1 LNS 84 HC ***(refd)***
Lubrizol Corp v. Esso Petroleum Co Ltd (No 5) [1998] RPC 727 ***(refd)***
Lux Traffic Controls Ltd v. Pike Signals Ltd [1993] RPC 107 ***(refd)***
Megnaway Enterprise Sdn Bhd v. Soon Lian Hock (No 2) [2009] 8 CLJ 130 HC ***(refd)***
Merck Sharp & Dohme Corp & Anor v. Hovid Bhd [2017] 1 LNS 53 HC ***(refd)***
Merck Sharp & Dohme Group & Anor v. Hovid Bhd [2019] 9 CLJ 1 FC ***(refd)***
Mohd Syamsul Md Yusof & Ors v. Elias Idris [2019] 7 CLJ 560 FC ***(refd)***
Ong Leong Chiou & Anor v. Keller (M) Sdn Bhd & Ors [2021] 4 CLJ 821 FC ***(refd)***
Pall Corp v. Commercial Hydraulics (Bedford) Ltd [1990] FSR 329 ***(refd)***
Palm Oil Research And Development Board Malaysia & Anor v. Premium Vegetable Oils Sdn Bhd [2004] 2 CLJ 265 FC ***(refd)***
PLG Research and Anor v. International Ltd and Ors [1993] FSR 197 ***(refd)***
Purefoy Engineering Co Ltd v. Sykes Boxall & Co Ltd & Ors [1955] 72 RPC 89 ***(refd)***
Quantel Ltd v. Spaceward Microsystems Ltd [1990] RPC 83 ***(refd)***
Radion Trading Sdn Bhd v. Sin Besteam Equipment Sdn Bhd & Ors [2010] 6 CLJ 334 HC ***(refd)***
Ranbaxy (Malaysia) Sdn Bhd v. El Du Pont De Nemours And Company [2011] 1 LNS 16 HC ***(refd)***
Spind Malaysia Sdn Bhd v. Justrade Marketing Sdn Bhd & Anor [2018] 4 CLJ 705 FC ***(refd)***
Spind Malaysia Sdn Bhd, Genelabs Diagnostics Pte Ltd v. Institut Pasteur [2001] 1 SLR 121 ***(refd)***
The General Tire & Rubber Company v. The Firestone Tyre and Rubber Company Limited And Others [1972] RPC 457 ***(refd)***
University of London Press Ltd v. University Tutorial Press Ltd [1916] 2 CH 601 ***(refd)***
Venu Nair & Anor v. Public Bank Bhd [2017] 6 CLJ 211 CA ***(refd)***

Legislation referred to:
Copyright Act 1987, ss. 3, 7(1)(c), (2), (2A), (3)(a), (4), 13(1), 36, 42
Patents Act 1983, s. 14(1), (2)(a)
Rules of Court 2012, O. 18 r. 7(1)

Other source(s) referred to:
Khaw Lake Tee and Tay Pek San, *Khaw on Copyright Law in Malaysia*, 4th edn, Lexis Nexis 2017, p 33
Professor Dr Khaw Lake Tee, *Copyright Law in Malaysia*, 1st edn, Butterworths Asia 1994, paras 87-88

For the appellant - Cyrus Das, Teo Bong Kwang & Eugene Ee Fu Xiang; M/s Wong Jin Nee & Teo
For the respondents - Ambiga Sreenevasan, Ken St James, Janini Rajeswaran, Desmond Louis, Sarah Ho Yixin, Jonathan Gerard & Anishaa Sundramoorthy; M/s Ken St James

[Editor's note: For the Court of Appeal judgment, please see Sungei Kahang Palm Oil Sdn Bhd & Anor v. YKL Engineering Sdn Bhd [2020] 1 LNS 1072 (affirmed).]

Reported by Suhainah Wahiduddin

A

JUDGMENT

Azahar Mohamed CJ (Malaya):

Introduction

B **[1]** This is an appeal against the decision of the Court of Appeal which reversed the High Court's decision that allowed the appellant's claim for patent and copyright infringements against the respondents.

[2] The appellant's claims revolve around its Malaysian Patent No. MY139512-A relating to a machine used in the oil palm industry known as the 'Fruit Bunch Splitter' ("Fruit Bunch Splitter") ("the appellant's C patent") and the design drawings relating to the Fruit Bunch Splitter and its component parts ("design drawings").

[3] The appellant sued both the respondents at the High Court for infringement of the appellant's patent and infringement of copyright D subsisting in the design drawings of the Fruit Bunch Splitter.

[4] The High Court found in favour of the appellant and held that the respondents had infringed the appellant's patent and the copyright subsisting in the design drawings of the Fruit Bunch Splitter.

E **[5]** The Court of Appeal took a diametrically opposite view. The Court of Appeal in effect found that the appellant's patent was invalid, copyright did not subsist in the design drawing of the Fruit Bunch Splitter, and that in any event, there was no infringement of copyright.

[6] After hearing the parties, we adjourned the matter for our deliberation. F We now give our decision and the grounds for the same. I will only deal with the questions relating to patent law. The question concerning copyright law will be dealt with in this judgment by our learned sister, Rohana Yusuf, PCA.

The Parties

G **[7]** The appellant is a company incorporated in Malaysia and is in the business of designing and manufacturing specialised machinery and equipment for palm oil processing. The appellant is the registered proprietor of the appellant's patent which was filed on 12 January 2006 and subsequently granted on 30 October 2009. The appellant's patent has been duly renewed and is therefore valid and subsisting at all material times.

H **[8]** The first respondent is a company incorporated in Malaysia and is in the business of operating a palm oil factory including processing fresh fruit bunches ("FFB") of palm oil. The first respondent has been in the palm oil milling business since 1994.

I

[9] The second respondent is a company incorporated in Malaysia and is in the business of manufacturing, servicing and troubleshooting technical and other related issues concerning machineries in plant construction for palm oil mills, wood and pulp processing and industrial plants and companies since 1988.

The Patent

[10] The invention relates to a machine that reduces the size of palm oil FFB by splitting them into smaller pieces.

[11] In the 'background of the invention', the appellant's patent describes the prior art of the comprising apparatus or machines where the palm oil FFB are either wholly inserted into the sterilising process or manually cut into smaller pieces. This apparently increased the cooking time or slowed down the processing whilst the manual cutting required a large amount of labour. The invention is said to address this problem by providing a machine that can reduce the size of the FFB before they are sterilised. The invention also apparently provides a convenient means of collecting the FFB after the splitting.

[12] In the 'abstract', the subject matter of the appellant's patent is stated as an apparatus for splitting palm oil and other fruit bunches comprising two parallel, inward and oppositely revolving drums which are fitted with sharp spikes in order to split large fruit bunches, wherein the drums are rotated by a high torque motor and are capable of splitting fruit bunches upwards of 60kg and where the split fruit bunches fall to a collecting receptacle on the underside of the splitter housing.

[13] There are 12 claims in the patent, of which claim 1 is independent whilst the remaining eleven claims (claims 2 to 12) are ultimately dependent on claim 1.

Factual Background

[14] On or about 15 April 2009, the appellant approached the first respondent to showcase its Fruit Bunch Splitter. On 24 April 2009, the appellant installed its Fruit Bunch Splitter at the first respondent's premises for test run purposes and to conduct a demonstration with a view to a sale. The appellant provided a quotation for the sale of the Fruit Bunch Splitter. The sale was however, not concluded despite numerous follow-ups by the appellant. Evidently, the first respondent viewed it as too costly.

[15] The dispute between the parties arose on or about 15 April 2011 when the appellant received information that the first respondent had been operating two units of oil palm fruit bunch splitters in its factory which closely resembled its Fruit Bunch Splitter. Upon visiting the first

A respondent's premises, the appellant found that the first respondent had indeed installed two units of oil palm fruit bunch splitters. As it turned out, the first respondent purchased the two units from the second respondent ("the SK Machines"). The first SK Machine was purchased in September 2009 whilst the second was purchased in January 2010. The appellant B claimed that both the SK Machines were made in accordance with the invention disclosed and claimed in the specifications of the appellant's patent.

The High Court Proceedings

C **[16]** Subsequently, the appellant sued both the respondents for infringement of its patent and copyright in respect of the manufacturing and the use of the SK Machines. In substance, the appellant's case is that the second respondent infringed the appellant's patent by manufacturing and selling two units of the SK Machines to the first respondent and that the first respondent had infringed the appellant's patent by using the SK Machines. D

[17] The respondents denied the allegations of patent infringement and counterclaimed to invalidate the patent for:

(i) lack of novelty, by virtue of the prior art which was disclosed to the public prior to the filing date of the appellant's patent (12 January 2006); E and/or

(ii) obviousness, as having regard to the prior art and common general knowledge, the invention which was the subject matter of the appellant's patent did not involve an inventive step.

F **[18]** The prior art, which was specifically pleaded by the respondents, among others are:

(i) drawings of the Kim Loong machine ("Kim Loong drawing") created on first August 2003; and

(ii) a machine comprising the same features located and operating at Keck G Seng Berhad in 2002 ("the prototype/machine at Keck Seng").

[19] During the trial of the action, specifically after the appellant's case had closed and its experts had been released, the respondents sought leave to re-amend their amended defence and counterclaim which had already been H amended once pursuant to the Court of Appeal's order dated 25 June 2013 to introduce an additional prior art in the form of an alleged prior use of a machine known as the "Desa Kim Loong machine".

[20] The said application was dismissed by the High Court, whose decision was affirmed on appeal by the Court of Appeal. In point of fact, the Desa I Kim Loong machine was therefore not a pleaded prior art.

Decision Of The High Court

[21] As we have alluded to earlier, the High Court found in favour of the appellant and concluded that the respondents had infringed the appellant's patent. Accordingly, the High Court dismissed the respondents' counterclaims.

[22] In considering the issue of novelty, the High Court rejected the evidence relating to the Desa Kim Loong machine as a prior art as it was not a pleaded prior art and could not be legally admitted for consideration as one of the prior arts to challenge the validity of the appellant's patent.

[23] On the issue of lack of inventive step, the High Court made a finding that the appellant's patent is inventive and not obvious to persons skilled in the art at the material time.

Decision Of The Court Of Appeal

[24] The Court of Appeal allowed the respondents' appeal and set aside the whole of the High Court's decision. For that reason, the respondents' counterclaims were allowed while the appellant's claims were dismissed. Principally, the Court of Appeal found that the appellant's patent was invalid.

[25] The appellant's patent was invalidated on the ground of anticipation by prior art due to existence of the Desa Kim Loong machine (which was not pleaded) and the prototype/machine at Keck Seng.

[26] On the issue of inventive step, the Court of Appeal found as a fact that the purported inventive concept is obvious to the normally skilled but unimaginative addressee in the art at the priority date to whom has been imputed the common general knowledge in the relevant art.

Questions Of Law On Appeal To The Federal Court

[27] This court granted leave to the appellant to appeal against the decision of the Court of Appeal on the following questions of law:

(1) Where a defendant invokes s. 14(2)(a) of the Patents Act 1983 (the Act) to raise the issue of anticipation by prior art to dispute the novelty of the plaintiff's patent, whether the defendant is obliged by law to plead with specificity the particulars of prior art relied upon by him to defeat the registered patent?

(2) In a patent trial where anticipation is raised to challenge the validity of a patent, whether a defendant should be allowed to rely on prior art documents and/or prior use which were not specifically pleaded in its attempt to invalidate the patent?

A (3) Whether a patent appeal had miscarried where the appellate court had disregarded a prior decision of the appeal court itself in the same case to disallow reliance on an item of alleged prior art which the High Court had loyally followed subsequently by disregarding the said item in arriving at its decision?

B (4) Can s. 14(2)(a) of the Act on public disclosure of a prior art apply where there has been an unauthorised disclosure to a third party of the prototype of the machine invented by the plaintiff?

(5) Whether a defendant could invalidate a patent on the ground of anticipation pursuant to s. 14(2)(a) of the Act where it is a case of an unauthorised disclosure of the plaintiff's prototype machine C installed on a private property for experimentation by the plaintiff?

(6) If claim 1 of a patent is declared to be invalid, is there a legal duty for the court to examine each and every dependent claim and decide individually whether the dependent claim is valid and thereafter to decide whether any of the dependent claims has been infringed? D

(7) Having regard to the concept of originality in copyright law which is distinct from the concept of novelty in patent law, whether the design drawings of an article (the work) would independently be eligible for copyright protection under s. 7(2), (2A) and (4) of the Copyright Act 1987 as artistic works?

E **[28]** Questions 1 to 6 relate to patent law. Question 7 concerns copyright law. As said earlier, I will only deal with questions relating to patent law.

Questions 1 And 2

[29] These questions raise the issue of 'prior art', which is the basis F requirement of s. 14 of the Patents Act 1983 ("the PA 1983"). Both the questions address whether a prior art relied upon to establish lack of novelty *vis-a-vis* an invention claimed in a patent must be specifically pleaded, and if not specifically pleaded, whether evidence in relation thereto may be admitted and relied upon. Questions 1 and 2 relate only to the Desa Kim G Loong machine. It bears emphasis that Desa Kim Loong machine was not pleaded by the respondents as an item of prior art to invalidate the appellant's patent for lack of novelty.

[30] The real point in both the questions arose from certain parts in the Court of Appeal's ground of judgment wherein the appellant's patent was H invalidated by the Court of Appeal on the ground of 'anticipation by prior art' pursuant to ss. 14(1) and (2)(a) of the PA 1983. The Court of Appeal held that the appellant's patent had been anticipated by the Desa Kim Loong machine. The Court of Appeal held that the evidence relating to the Desa Kim Loong machine (which was not pleaded) was admissible to establish the I pleaded material facts as it occasioned no surprise and caused no prejudice or injustice to the appellant. The respondent had pleaded the material facts - that the invention which was the subject matter of the appellant's patent was

not new (had been anticipated) and was therefore invalid. The Court of Appeal held that the appellant was not taken by surprise by the introduction of the evidence relating to the Desa Kim Loong machine when the same was introduced well before the commencement of the trial. Evidence was also led on the same during the trial. The Court of Appeal found that the appellant suffered no surprise, prejudice or injustice.

Contentions Of Parties In Respect Of Questions 1 And 2

[31] The appellant's contentions can be summarised as follows. The rules on pleadings are especially stringent in patent suit where the patent holder must be informed of the precise basis, namely the prior art relied on by the attacker to invalidate his patent. By established rule, the parties' experts would be required to provide their opinion on the relevant prior art to assist the court on the issues of invalidation and infringement of the patent. Hence, the necessity for the defendants to give notice by pleading of the relevant prior art which was relied on to invalidate the patent. It is to prevent surprise and trial by ambush. Further, where prior user in the form of a machinery is relied upon to invalidate the patent, such as the respondents' reliance on the non-pleaded Desa Kim Loong machine in this case, the respondents must identify the prior user with sufficient particulars including the time and place of its use. The respondents must point out *in situ* the particulars of the apparatus to which he refers, and to procure it, if possible, for the full inspection thereof by the appellant. The Court of Appeal's decision in admitting the Desa Kim Loong machine and invalidating the appellant's patent based on the same had clearly prejudiced and caused injustice to the appellant.

[32] The respondents' main contentions are as follows. In Malaysia, unlike other Commonwealth jurisdictions, there is no specific legal requirement that prior art must be specifically identified, pleaded and particularised. Based on the general principles of pleadings, what must be pleaded are the material facts which are facts necessary for the purpose formulating a complete cause of action or defence. When a defence of anticipation is raised, the material facts which must be pleaded to formulate a complete cause of action is that the patent is invalid by reason of the fact that the invention which is the subject of the claims lacks novelty. The prior art which establishes the said material fact is evidence and thus, does not need to be specifically pleaded. Given that prior art (or prior use) is evidence relevant to the pleaded defence, such evidence ought to be admissible even if it is not specifically pleaded and a party ought to be allowed to rely on the same to invalidate a patent subject to of course, to the principle that no prejudice or injustice is occasioned. The respondents had pleaded the material facts – that the invention which was the subject matter of the appellant's patent was not new and was therefore invalid. On the facts here, the appellant was not taken by surprise by the introduction of the evidence and that the appellant suffered no surprise, prejudice or injustice.

A **Findings and Analysis In Respect Of Questions 1 And 2**

[33] These questions raise the issue of 'prior art', which is the basis requirement of s. 14 of the PA 1983 which provides:

Novelty

B 14. (1) An invention is new if it is not anticipated by prior art.

(2) Prior art shall consist of:

(a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention;

C

(b) ...

[34] Novelty is a prerequisite for patentability. In order to consider the nature of novelty it is necessary to bear in mind the provisions of s. 14 of the PA 1983. The provisions require an invention to be new in the sense that D on the date of filing of patent application, it should not form a part of the state of the art. The invention is not novel if it is anticipated by prior art and prior art consists of everything disclosed to the public anywhere in the world by written publication, oral disclosure and by use or in any other way before the priority date of the patent application claiming the invention. The E priority date is the date by which the novelty of the invention is to be judged. In order for any prior art to provide sufficient disclosure, the disclosure must be enabling in nature, that is to say, giving sufficient and clear instructions or teachings to arrive at the disputed invention (see *The General Tire & Rubber Company v. The Firestone Tyre and Rubber Company Limited And Others* [1972] F RPC 457 ("*General Tire & Rubber Company*").

[35] Undeniably, in our jurisdiction, unlike others such as the United Kingdom, Australia and Singapore, there are no specific provisions, whether in the PA 1983 and the Patents Regulations 1986 that require a party to plead with specificity the prior art a party intends to rely on to invalidate a patent G for lack of novelty or otherwise. The questions therefore fall to be decided by reference to the Rules of Court 2012 ("RHC 2012"). The Order of the RHC 2012 which governs the general principles of pleadings is O. 18 r. 7(1). This rule lays down the requirements of the pleading, namely that pleadings should be statements in summary form, stating only the material facts in a manner which is brief and to the point, and not the evidence by which they H are to be proved (see *Malaysian Civil Procedure 2021*, Sweet & Maxwell, Vol. 1, para. 18/7/1). Material facts are facts which are necessary for the purpose of formulating a complete cause of action and for establishing a defendant's defence (see *Bruce v. Odhams Press Ltd* [1936] 1 All ER 287).

I **[36]** The question than arises: is a prior art a 'material fact' that must be pleaded with specificity by a party seeking to invalidate a patent for lack of novelty? In addressing this question, it is important to note that in a case where a party claims that a patent is not a patentable invention as it is not

new and does not involve an inventive step, the parties' expert is required to provide their opinion on the relevant prior art to assist the court on the issues of invalidation of the patent, validity of the patent must be assessed by the court with the aid of an expert often referred to as a "person having ordinary skill in the art" (see *Spind Malaysia Sdn Bhd v. Justrade Marketing Sdn Bhd & Anor* [2018] 4 CLJ 705; [2018] 4 MLJ 34; FC ("*Spind Malaysia Sdn Bhd*"). More often than not, patent litigations involved technical and complex construction of the patent itself and its specifications. The court is informed by the expert as to the meaning of technical words and phrases and what was at the relevant time, the common general knowledge as possessed by the notional skilled man or an appropriately skilled addressee (see *General Tire & Rubber Company* (*supra*) and *Kirin-Amgen Inc v. Hoechst Marion Roussel Ltd* [2005] 1 All ER 667). As explained by Adous J in the case of *Lubrizol Corp v. Esso Petroleum Co Ltd (No 5)* [1998] RPC 727:

> Patent specifications (description) are intended to be read by persons skilled in the relevant art, but their construction is for the court. Thus, the court must adopt the mantle of the notional skilled addressee and determine, from the language used, what the notional skilled addressee would understand to be the ambit of the claim. To do that it is often necessary for the court to be informed as to the meaning of technical words and phrases and what was, at the relevant time, the common knowledge; the knowledge that the notional skilled man would have.

[37] In our judgment, the Court of Appeal failed to appreciate that this was a patent case and that the respondents were relying on items of prior art with the object of invalidating the appellant's patent. For this reason, the importance of giving notice to the appellant by the respondents in respect of the Desa Kim Loong machine and of specific pleading by the respondents seeking to invalidate the appellant's patent can never be overemphasised. A party attacking the validity of a patent should particularise the prior art in question in the pleading so that the parties and their experts may come to the trial prepared to meet the case which is intended to be proved against them, and that there may be no taking by surprise (see *Holliday v. Heppenstall* [1889] 6 RPC 320).

[38] In *Alsop Flour Process Ld v. Flour Oxidizing Company Ld* [1908] 25 RPC 477, the House of Lords refused to consider a non-pleaded prior art given the danger and unfairness that may occasion if it were to do so. Lord Loreburn observed as follows:

> I find that this Objection was not mentioned in the Particulars, and that though a few questions were put in cross-examination of the patentees' witnesses relating to the point, no notice was given of the purpose for which they were put, no amendment asked or granted at the trial, no such Objection made when Petitioners opened their case at the trial, and it was only in the Petitioners' reply that the point was raised. Few things could

A be more dangerous or unfair than to admit now, in a case so complicated and full of details, an Objection which has such a history. For these reasons I must decline to entertain it.

[39] Learned counsel for the appellant brought to our attention two High Court cases, namely *B Braun Melsungen AG & Anor v. Terumo Kabushiki* B *Kaisha & Anor* [2011] 1 LNS 947; [2011] 6 AMR 101 and *Ranbaxy (Malaysia) Sdn Bhd v. El Du Pont De Nemours And Company* [2011] 1 LNS 16; [2011] 1 AMCR 857. Essentially, these cases have likewise required a party seeking to invalidate a patent on lack of novelty to plead and particularise all the relevant prior art relied on with specificity as a matter of practice and C prudence. The approach taken by these High Court cases is in accord with the principles derived from the cases that we have discussed earlier.

[40] Our attention was then drawn by learned counsel for the respondents to the case *Merck Sharp & Dohme Corp & Anor v. Hovid Bhd* [2017] 1 LNS 53 where the High Court took a different approach. The plaintiff in that case D objected to the defendant's reliance of two prior publications which had not been pleaded. The High Court dismissed the objection, among others, on the ground that it was clear from the amended defence and counterclaim where the words '*inter alia*' were used that the publications pleaded as prior art were not exhaustive. We agree with the arguments of learned counsel for the E appellant that the above approach in relying on qualifications such as '*inter alia*' and limited to', which is similarly adopted by the Court of Appeal in the present case, are unprecedented in patent litigation as it is contrary to the basic principle of a full disclosure to prevent any surprise during the patent trial and to afford the plaintiff, particularly its experts, with the opportunity F to deal with all the prior art relied on by the defendant.

[41] In the present case, neither the appellant nor its experts were afforded the opportunity to scrutinise the Desa Kim Loong machine in great detail and to submit their written opinions/reports on the same, as is the case in every patent trial. The respondents' introduction of the non-pleaded Desa Kim G Loong machine (in the form of a CD-ROM) at the eleventh hour and the Court of Appeal's decision to admit the same into evidence had handicapped the appellant in its defence of their patent's validity. In this way, the Court of Appeal's decision in admitting the Desa Kim Loong machine and invalidating the appellant's patent based on the same had clearly prejudiced H and caused injustice to the appellant.

[42] Based on all the above reasoning, we conclude that it is a requirement in law on the part of a party to plead with specificity the particulars of prior art a party intends to rely on to invalidate a patent for lack of novelty or otherwise. We therefore answer questions 1 and 2 in favour of the appellant. I Hence, questions 1 and 2 should be answered in the affirmative.

Question 3

[43] Question 3 addresses the issue whether the appeal has miscarried when the Court of Appeal disregards its earlier decision of 'disallowing reliance on an alleged prior art'.

[44] A point to note is that question 3 arises by reason of the appellant's objections, during the trial of the action, to the admissibility of the Desa Kim Loong machine on the ground that the said prior art was not pleaded. The appellant applied for leave to amend the defence and counterclaim to specifically plead the Desa Kim Loong machine. The appellant objected to the same and the application was dismissed by the High Court. The respondents appealed to the Court of Appeal and the Court of Appeal upheld the High Court's decision. There was no further appeal by the respondents to the Federal Court. Despite the Court of Appeal's earlier decision in dismissing the respondents' application to re-amend their pleadings, the Court of Appeal in the present matter had admitted and relied on the non-pleaded Desa Kim Loong machine as a prior art against the patent.

[45] The question then arises: can the Court of Appeal rely on an item of prior art rejected by a previous decision of another panel of the Court of Appeal in the same case?

Contentions Of Parties In Respect Of Question 3

[46] The appellant contended that by disregarding its previous decision on the same issue (which ought to be treated as final and binding upon the parties) and allowing the Desa Kim Loong machine to be admitted, the Court of Appeal had contravened the principle of *res judicata* and had seriously prejudiced the appellant.

[47] On the other hand, the respondents contended question 3 is premised on the incorrect assumption that (i) all prior art must be specifically pleaded and (ii) the earlier decision of the Court of Appeal necessarily equates to the Court of Appeal having previously 'disallowed reliance on an item of alleged prior art'. The Court of Appeal did not set aside or reverse; ignore or disregard the earlier decision or order of the Court of Appeal and the issue of *res judicata* or whether the appeal had miscarried does not arise on the facts here. The Court of Appeal merely reversed a ruling on the admissibility of the evidence relating to the Desa Kim Loong machine (which was relevant to the pleaded defence of anticipation) which it is entitled to do.

Findings And Analysis On Question 3

[48] It has to be noted that this question flows from the earlier two questions. For this reason, the contentions by the respondents are clearly untenable in light of our decision that a specific prior art must be pleaded if a party intends to rely on it to invalidate a patent for lack of novelty or otherwise.

[49] Even more to the point is that, since there was no appeal to the Federal Court against the earlier dismissal of the respondents' amendment application, the decisions of the High Court and the earlier Court of Appeal pertaining to the treatment of the non-pleaded Desa Kim Loong machine becomes final and could not be re-opened by the present Court of Appeal at a later stage during the appeal proper. By disregarding its previous decision on the same issue (which ought to be treated as final and binding upon the parties) and allowing the Desa Kim Loong machine to be admitted, the Court of Appeal had contravened the principle of *res judicata*. The principle of *res judicata* is based on the need of giving a finality to judicial decisions. Once a *res* is *judicata*, it shall be not adjudged again (see *Government Of Malaysia v. Dato Chong Kok Lim* [1973] 1 LNS 35; [1973] 2 MLJ 74 HC; *Venu Nair & Anor v. Public Bank Bhd* [2017] 6 CLJ 211; [2017] 5 MLJ 529 CA; and *CIMB Bank Bhd v. Sebang Gemilang Sdn Bhd & Anor* [2015] 7 CLJ 870; [2015] MLJU 2148; CA). It does not matter that the earlier decision was made at the interlocutory stage; it is nevertheless binding on the parties and the Court of Appeal. A decision given by a court at one stage on a particular matter or issue is binding on it at a later stage in the same suit or in a subsequent suit (see *Hartecon JV Sdn Bhd & Anor v. Hartela Contractors Ltd* [1997] 2 CLJ 104; [1996] 2 MLJ 57 CA). The Court of Appeal could not rely on an item of prior art rejected by a previous decision of the Court of Appeal itself in the same case. There is nothing in the Court of Appeal's judgment to indicate that its earlier decision was set aside or disregarded on the basis of illegality or lack of jurisdiction. Instead, the court found that:

> [126] ... At the trial, the appellants sought to amend their pleadings to include the Desa Kim Loong Machine as another prior art. The amendment was refused and the decision affirmed on appeal. There are no grounds available and we loathe to speculate on the reasons for the refusal.

[50] The Court of Appeal therefore erred in holding that "the learned judge was in error in failing to admit into evidence and also in not considering the Desa Kim Loong machine as one of the several prior arts" given that the High Court at the trial was only following the earlier Court of Appeal's decision, as it is bound to, in excluding the Desa Kim Loong machine from the body of prior art.

[51] In the circumstances, question 3 must be answered in the affirmative.

Questions 4 And 5

[52] We come now to the more delicate and difficult questions which raise the issue of the scope of the 'public disclosure' requirement under s. 14(2)(a) of the PA 1983 to invalidate a registered patent. Questions 4 and 5 relate only to the prototype/machine at Keck Seng.

[53] It is important to emphasise the prior art which was specifically pleaded by the respondents in the amended defence and counterclaim and amended rejoinder and reply to defence counterclaim is the prototype/ machine at Keck Seng located and operating at Keck Seng Berhad in 2002.

[54] Questions 4 and 5 arise by reasons of the following background facts. At trial, Tan Tiam Poh ("DW2") who invented the SK Machines testified that he had himself seen the prototype/machine at Keck Seng prior to the priority date when he was carrying out contract work for Keck Seng in 2002. DW2 told the court that he had easy unrestricted access to the prototype and that any contractor on Keck Seng's premises could see the prototype without any prohibition. In short, the respondents' case was that there had been prior disclosure of the prototype and thereby the Fruit Bunch Splitter.

[55] On the other hand, Yeo Koon Lean ("PW1") had testified that the prototype was kept a secret at all material times of experimentation where the respondents including DW2 would never have been allowed or authorised to view the prototype. The second respondent or its workmen were only authorised access to the area earmarked for the lipofrac plant which the second respondent was appointed by Keck Seng to construct. PW1 explained that the prototype was kept on a raised platform and covered by a roof where only the authorised employees of Keck Seng would have had access to it. Access was also restricted because a lot of research and development was carried out at Keck Seng's premises located on private property. As a public listed company, Keck Seng had a policy on secrecy and confidentiality and its effect on the company's reputation and thus could not allow anyone to enter freely and put the company at risk if anything happened to the visitor.

[56] The above conflicting evidence brings into question the issue whether the prototype of a patented machine, which is kept on private property for testing purposes, could be a public disclosure within the meaning of s. 14(2)(a) of the PA 1983. This critical issue was however not dealt with at all by the High Court despite the parties had pleaded, led to the evidence and extensively addressed the issue. The High Court had failed to consider that the prototype was disclosed to the public and to the palm oil industry prior to the filing date of the appellant's patent.

[57] The Court of Appeal carefully examined and comprehensively evaluated the evidence relating to the prototype and found as a fact that the prototype had been disclosed to DW2, who was lawfully on Keck Seng's premises, had unrestricted access to the prototype and was free in law and equity to examine and use the information disclosed by the prototype. The Court of Appeal also found as a fact that the disclosure was an enabling disclosure and the prototype had therefore been disclosed to the public within the meaning of s. 14(2)(a) of the PA 1983.

A

Contentions Of Parties In Respect Of Questions 4 And 5

[58] In the main, the appellant contended that the crucial requirement under s. 14(2)(a) of the PA 1983 is that the disclosure must be a 'public' disclosure or a 'disclosure to the public'. It follows that a private 'disclosure' or a prototype model installed at private premises for testing purposes of
B experimentation is not within its ambit. The alleged prior art in question here is the prototype unit of the Fruit Bunch Splitter which was installed by the appellant at the premises of Keck Seng for private experimentation purposes. Furthermore, the Court of Appeal failed to appreciate that given the prototype was covered by metal coverings or plates on all sides, which made
C it not possible for anyone to view its parts and workings, the prototype did not satisfy the 'enabling disclosure' test which requires the essential features or integers of the invention to be disclosed to the public that would enable the public to re-create the invention, before it can be regarded as a prior art that anticipated the patent. The Court of Appeal also failed to appreciate the
D well-established position in other jurisdictions that the experimentation of an invention's prototype in a public setting (even without any express or implied obligation of secrecy on the bystander) does not automatically mean that the patented invention has been disclosed to the public and be regarded as an item of prior art.

E **[59]** The main contentions of the respondents are as follows. Both questions 4 and 5 are premised entirely on the purported 'fact' that the disclosure of the prototype/machine at Keck Seng was 'unauthorised'. This is an incorrect assumption of fact and is in direct contradiction of the findings of fact by the Court of Appeal. With regard to what amounts to a 'disclosure to the public'
F where information (whether in documentary form or in the form of the invention itself) has been communicated or made available to at least one member of the public who is free in law and equity to use it, (and that disclosure is an enabling disclosure) that information has been disclosed to the public and forms the prior art. There is no need to prove that anybody
G saw the prior art, provided that the relevant disclosure was in public. Where such information is communicated under the obligation of confidence, it follows that the recipient will not be free in law or equity to use it. Disclosure under such circumstances will not amount to disclosure to the public. This principle applies equally to prototype. If the prototype was
H however installed on a private property such private factory premises, whether for experimentation or otherwise, whether there is disclosure to the public will depend on the facts of the case. The Court of Appeal found as a fact the prototype/machine at Keck Seng had been disclosed to the public within the meaning of s. 14(2)(a) of the PA 1983 and that the disclosure was an enabling disclosure.

I

Findings And Analysis On Questions 4 And 5

[60] As seen earlier, by virtue of s. 14(1) of the PA 1983 an invention is new if it is not anticipated by prior art. "Prior art" is defined in s. 14(2) of the PA 1983 as consisting of:

> (a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or any other way, prior to the priority date of the patent application claiming the invention;

[61] In other words, an invention can only be validly treated as a patentable invention if it is new or novel and has never been disclosed to the public in the sense set out in s. 14(2)(a) of the PA 1983.

[62] In deliberating these questions, we note that the contentions of the appellant are not free from difficulties. In the first place, as argued by learned counsel for the respondents, both questions 4 and 5 are premised on the purported 'fact' that the disclosure of the prototype was 'unauthorised'. In this context, we have, with care, read the grounds of judgment of the Court of Appeal. The Court of Appeal extensively examined and evaluated the evidence relating to the prototype/machine at Keck Seng (which the High Court had failed to do) and made, among others, the following findings of fact:

At para. 172:

> [172] According to the respondent, there can be no disclosure due to the confidentiality, privacy and secrecy. On that issue, we find those conditions actually not established.

At paras. 176, 177 and 179:

> [176] From the evidence, we find none of the requirements met. It is wrong in law to impose any such relationship, even in equity, between the 2nd appellant and the respondent given the particular facts and circumstances in this appeal. The prototype was not even housed in the respondent's premises at all ... Of huge significance is the fact that the prototype was incorporated into and formed part of the whole process or mill operations at Keck Seng, not for a brief while, but for a considerable period of time, some 6 years or even more.
>
> [177] There were also no indications to warn or alert that the prototype was even a prototype or security measures emplaced to protect or secure the prototype. The 15 feet height of the platform where the prototype was placed does not pose anything unusual from what we can observe of the whole process chain and structure. There is also no evidence of the respondent or even PW1 being present at all times at Keck Seng at least in 2002 when DW2 was lawfully at Keck Seng's factory.
>
> [178] ...

A [179] Absent particular arrangements and evidence of security or access restrictions, it would be difficult to impose any duty of confidentiality on third parties such as the second appellant and DW2 who undeniably had a legitimate reason to be present at Keck Seng in 2002, long before the priority date ...

B **[63]** The above-mentioned passages clearly show that the Court of Appeal found as a fact that the prototype/machine at Keck Seng was housed on third party premises, was incorporated and formed part of the whole process or mill operations at Keck Seng for some six years or more, DW2 to whom the prototype/machine at Keck Seng was disclosed was lawfully on Keck Seng's
C premises and there was no obligation of confidentiality imposed on DW2. We, therefore, agree with the submissions of learned counsel for the respondents to the effect that both questions 4 and 5 are premised on an incorrect fact that the disclosure of the prototype/machine at Keck Seng was "unauthorised". This in itself is a sufficient ground for this court to decline
D to answer questions 5 and 6 (see *Ho Tack Sien & Ors v. Rotta Research Laboratorium S.p.A & Anor; Registrar Of Trade Marks (Intervener) & Another Appeal* [2015] 4 CLJ 20; [2015] 4 MLJ 166; FC, and *Ong Leong Chiou & Anor v. Keller (M) Sdn Bhd & Ors* [2021] 4 CLJ 821; [2021] 3 MLJ 622; FC).

[64] Still, we will deal with some of the issues raised by the parties as they
E involved important matter relating to patent law. First, what then constitutes 'disclosed to the public'? It is established principles that where information (whether in documentary form or in the form of the invention itself) has been communicated or made available to at least one member of the public, who is free in law and equity to use it, that information has been disclosed to the
F public and forms the prior art. However, where such information is communicated under obligation of confidence, it follows that the recipient will not be free in law or equity to use it. Disclosure under such circumstances will not amount to disclosure to the public (see *Bristol-Meyer Co's Application* [1969] RPC 146; *PLG Research and Anor v. International Ltd and Ors* [1993] FSR 197; *Quantel Ltd v. Spaceward Microsystems Ltd* [1990]
G RPC 83 (ChD)). The general principles relating to what constitutes 'disclosed to the public' apply equally to prototype. From decided cases it is clear that in the case of a prototype, if the prototype has been made available to at least one member of the public who is free in law and equity to examine it and/ or disclose the information, that prototype has been 'disclosed to the public'.
H If it was, however, disclosed under an obligation of confidence, it has not been disclosed to the public (see *Lux Traffic Controls Ltd v. Pike Signals Ltd* [1993] RPC 107 (ChD), *Pall Corp v. Commercial Hydraulics (Bedford) Ltd* [1990] FSR 329). In respect of prototypes installed on private property, it must be shown that the prototype was actually imparted to at least one person skilled
I in the art who was free in law to use it or divulge it to anyone else as he pleases in order for the disclosure to amount to disclosure to the public (see *Folding Attic Stairs Limited v. The Loft Stairs Company Limited & Anor* [2009] EWHC 1221 (PatCt)).

[65] Applying the above principles, we agree with the submission of learned counsel for the respondents that the Court of Appeal correctly held that there was sufficient evidence to establish that the prototype/machine at Keck Seng had been disclosed within the meaning of s. 14(2)(a) of the PA 1983. On consideration of all the evidence contained in the appeal record, the Court of Appeal is entitled and correct in making those findings. On the facts the disclosure of the prototype/machine at Keck Seng whilst on the third-party private premises were clearly not unauthorised. The prototype/machine at Keck Seng was incorporated into and formed part of the whole process or mill operations at Keck Seng's premises. DW2 was lawfully on the premises and had easy unrestricted access to the prototype/machine at Keck Seng. There were no security measures or evidence of restrictions to access the same. There is further no evidence that obligation of confidence. DW2 was free in law and equity to examine and use the information disclosed by the prototype/machine at Keck Seng. On the facts, we are unable to agree with the submissions of learned counsel for the appellant that the prototype/machine at Keck Seng was installed confidentially or privately.

[66] We have not overlooked the issue that the disclosure in the prior art must be an enabling disclosure to anticipate the claimed invention. It is settled law that for there to be anticipation, there must be an enabling disclosure. A prior art is deemed to have anticipated a patented invention if there is sufficient information conveyed to the public that would enable anyone who is in receipt of the information to be able to reproduce or duplicate the patented invention (see *General Tire & Rubber Company (supra), Generics (UK Ltd And Others v. H Lundbeck A/S* [2009] All ER 963, *Spind Malaysia Sdn Bhd, Genelabs Diagnostics Pte Ltd v. Institut Pasteur* [2001] 1 SLR 121 and *Cylinders Ptv Ltd v. Marks* (1996) 144 ALR 627).

[67] Reverting to the present case, the Court of Appeal also went on to consider whether the disclosure was an 'enabling disclosure'. In this regard, the Court of Appeal at para. 194 of its grounds of judgment held:

> [194] DW2's observations of the machine at Keck Seng obviously was sufficient to enable him to learn from the machine and make one for Kim Loong in 2002/2003. The Kim Loong drawings corroborate the second appellant's case. DW2 explained himself as someone who was skilled in the art here and who was able to follow the operations of the machine and learnt from it.

[68] Earlier, at para. 162 the Court of Appeal observed:

> [162] DW2 had "observed the operation of the machine" and had "learnt from if to the extent that he or the second appellant went on to build one for Kim Loong. DW2 even prepared the Kim Loong drawings based on his observations of the operations of the machine/prototype. And this was in 2002 with the machine built for Kim Loong in 2003.

[69] We find no plausible reasons to interfere with the findings of the Court of Appeal that the disclosure was an enabling disclosure.

[70] Based on all the above reasoning, since questions 4 and 5 are in substance premised on fact which is in direct contradiction with the findings of fact by the Court of Appeal and that the questions posed are subject to factual findings, we find it unnecessary to answer both questions.

Question 6

[71] This question essentially addresses whether the court must examine each and every dependent claim and thereafter decide individually if the claim is valid and infringed.

[72] We can deal with this question more briefly as the question of law has been answered in *Merck Sharp & Dohme Group & Anor v. Hovid Bhd* [2019] 9 CLJ 1; [2019] 12 MLJ 66; FC ("*Merck Sharp* FC"), where it was decided *inter alia* that the courts must construe and decide on the validity of the dependent claims separately even if the independent claim is adjudged to be invalid. In the words of *Merck Sharp* FC (*supra*):

> [124] For all these reasons we are constrained to depart from the decision in *SKB Shutters*. We reiterate that it is essential that when a court is tasked with ascertaining the validity of a patent comprising both independent and dependent claims, the trial court is bound to evidentially assess each of these claims separately.

Contentions Of Parties In Respect Of Question 6

[73] The appellant contended that this question stemmed from the Court of Appeal's finding that the patent's dependent claims 2 to 12 were invalid as a consequence of the invalidity the independent claim. The Court of Appeal's decision on this issue is erroneous and unsustainable as it is inconsistent with *Merck*, which decided *inter alia* that the courts must construe and decide on the validity of the dependent claims separately even if the independent claim is adjudged to be invalid.

[74] The respondents contended that the Court of Appeal did not conclude that the dependent claims 2 to 12 were invalid by reason of the invalidity of the independent claim 1.

Analysis And Findings In Respect Of Question 6

[75] We agree with the submissions of learned counsel for the respondents that the Court of Appeal did not conclude that the dependent claims 2 to 12 were invalid by reason of the invalidity of the independent claim 1. This can be seen from the judgment of the Court of Appeal as follows:

> Dependent claims
>
> [231] Our view remains unchanged even when we consider the dependent claims; whether in the configuration of the spikes; the shape of make of the spikes; the adjustable gap between the two drums; the nature of the

> body frame; the power source including the mechanical gearbox system; the control unit; or even in the way those drums rotate when powered. These features present and were already anticipated in each of the prior art discussed; especially in the prototype and the Desa Kim Loong Machine.
>
> [232] The claims in 2 to 12 are thus similarly invalid for the reasons discussed.
>
> ...
>
> [234] For the reasons set out above, the appeal ought to be allowed and the decision of the High Court be set aside. With the above conclusions, the matter of infringement further does not arise.

[76] In the other parts of the grounds of judgment, the Court of Appeal examined each dependent claim individually prior to coming to the decision that the dependent claims were invalid. This can be seen from their specific reference to the various features of each dependent claim at para. 231 of the grounds as well as at paras. 113 to 123 of the judgment. We conclude that in line with *Merck Sharp* FC (*supra*), the Court of Appeal did examine each dependent claim individually when coming to their decision that each dependent claim was invalid.

[77] In the circumstances of this case, it is unnecessary to answer question 6.

Conclusion On The Questions Relating To Patent Law

[78] We affirmed the specific findings of the Court of Appeal on the fact that the invention which is the subject the appellant's patent is not new by reason of the prior disclosure of the prototype/machine at Keck Seng within the meaning and conditions of s. 14(2)(a) of the PA 1983 and therefore the appellant's patent was invalid.

[79] For all these reasons, we unanimously dismiss the appellant's appeal relating to the appellant's patent.

Rohana Yusuf PCA:

Question 7

[80] We now come to the sole question posed on the issue pertaining to copyright in question 7. We hereby reproduce it again for clarity and convenience and it reads as below:

> Having regard to the concept of originality in copyright law which is distinct from the concept of novelty in patent law, whether the design drawings of an article (the Work) would independently be eligible for copyright protection under s. 7(2), (2A) and (4) of the Copyright Act 1987 as artistic works?

[81] This question raises the issue on the applicable test of "originality" for subsistence of copyright, and whether it is distinct from the concept of novelty in patent law.

[82] In gist, the appellant's case on copyright is that the design drawings of its Fruit Bunch Splitter were created by one of its employees. And these design drawings have been reduced to material form. The said author or creator, PW1 being an employee of the appellant, had expended substantial effort to render it original in character as envisaged under the copyright law.

[83] The appellant further maintained that the design drawings are artistic works within the meaning of s. 7(1)(c) of the Copyright Act 1987 ("CA 1987"). Pursuant to s. 42 of the CA 1987, PW1 had stated that he indeed had expended substantial effort into the design drawings of the Fruit Bunch Splitter.

[84] While the respondents' case in summary is this: No copyright subsisted in the said design drawings of the appellant since the works involved were not original. According to the respondents there had been existing prior arts in the design drawing of Kim Loong's machine in the year 2003, where the appellant had in fact copied from, when the appellant produced the design drawings of its Fruit Bunch Splitter in the year 2004.

[85] The respondents then maintained that even if copyright subsisted there was no infringement of the appellant's Fruit Bunch Splitter drawings, firstly because there was no causal connection. Secondly the respondents' SK Machines were adapted from an earlier prior art; Kim Loong drawing which was created earlier than the appellant Fruit Bunch Splitter.

Decision Of The High Court

[86] The High Court allowed the appellant's claim on copyright and found in summary as follows:

(i) there is copyright subsisting in the copyrighted works and three-dimensional embodiment of the machine belonging to the appellant. Reliance was placed by the High Court on the statutory declaration affirmed by PW1 which the High Court found to be unrebutted by the respondents;

(ii) there is an infringement of copyright by the respondents, and all the following ingredients have been met; in that:

(a) there is sufficient objective similarity between the respondents' SK Machines and copyrighted works as set out in Annexure G (our perusal of the appeal record showed that this Annexure was found in the appellant's submission at the High Court after trial);

(b) there is a causal connection between appellant's Fruit Bunch Splitter and SK Machines through the inference of copying (based on the substantial similarities); and

(c) the similarities between the appellant's Fruit Bunch Splitter as shown through the copyrighted works and the SK Machines constitute a substantial part of the original work.

Decision Of The Court Of Appeal

[87] The Court of Appeal disagreed with the High Court. The Court of Appeal in its judgment, held these:

> [262] From the sequence of events and for the reasons and findings as discussed above in relation to the patent, we find that there cannot be any copyright in view of the existence of the prior art documents relied on by the appellants. This includes the Prototype and the Desa Kim Loong Machine.
>
> [263] This makes the respondents' drawings in fact substantial reproductions of the Desa Kim Loong Machine and/or the other prior art documents relied on by the appellants in which case, it cannot be said that the respondent had expended sufficient skill and effort to render the original as mandated by the provisions of the Copyright Act 1987 [Act 332].

(The appellant referred to in the above is the respondents in this appeal, and *vice versa*).

[88] It can be discerned from the finding of the Court of Appeal above that there cannot be subsisting copyright in the appellant's design drawings for the reasons; Firstly, that there is no novelty in view of the existence of prior arts in the form of the unpleaded Desa Kim Loong machine and the prototype of the Fruit Bunch Splitter, rendering the appellant's design drawings to be not a new or original design. Secondly, the Court of Appeal found that the appellant had failed to fulfil the requirement of s. 7(3) of the CA 1987 in that the appellant failed to prove there was sufficient effort rendered in the design drawings in order to confer the appellant the negative rights laid out in s. 13(1) of the Act.

[89] The Court of Appeal went on further to hold that even if copyright subsists, there can be no infringement as there was no causal connection established.

Contention Of Parties On Question 7

[90] On the issue of subsistence of copyright, the appellant had criticised the Court of Appeal's finding and submitted that it had erred in its findings that no copyright subsisted due to their lack of "originality''. The lacking in originality as found by the Court of Appeal which was grounded purely on

A the basis of the existence of the alleged prior work as determined in the patent proceedings was not the correct test to be employed. In short, it was contended that the Court of Appeal should not have conflated the test for patent with that of copyright.

B **[91]** It was the case of the appellant that the denial of the subsistence copyright in the works for want of novelty or inventiveness as used in the patent proceedings, was unprecedented and not in accord with the settled legal test employed in copyright law. In doing so, the appellant contended, the Court of Appeal had in fact equated the concepts of "originality" in copyright law with "novelty" in patent law as one and the same.

C **[92]** Counsel for the appellant argued, the issue as to whether a work is a "substantial reproduction" of another prior art is only relevant to determine infringement of copyright but not to determine the subsistence of copyright. It was further submitted, in any event the scope of originality in copyright is wide. It includes a situation where a creator of later work, having taken D original elements in an earlier copyright work but at the same time expended labour and skill in creating his works. Pursuant to s. 7(4) of the CA 1987, having expending on an earlier work the appellant is entitled to the protection as articulated in s. 13(1). The appellant hence cannot be denied of those rights, even if it merely copied the earlier works once it is proven E that it had indeed contributed and expended on those earlier works.

[93] The appellant submitted, PW1 the author of the appellant's design drawings had testified at length before the learned trial judge on the substantial efforts he had taken in coming up with the design drawings. Particularly in his Q & A: 51-53 he testified the effort taken by him in that F design drawings which in law entitled the appellant to the right in copyright.

[94] To reinforce his expended effort PW1 had also referred to a statutory declaration affirmed by him on 5 December 2011 pursuant to s. 42 of the CA 1987. In his statutory declaration, he explained that there are two sets of design drawings created by him at two different stages. The first part of G the work was created on or before February 2004 which consisted of a simple schematic drawing. The second part of the work constituted the refined engineering drawing with a very detailed rendition.

[95] The respondents had no difficulty in agreeing that the concept of H "originality" in copyright law is distinct from the concept of "novelty" in patent law. However, the respondents maintained, the Court of Appeal was correct in holding no copyright subsisted in view of the existence of prior arts, and that the appellant had not proven to have expended sufficient skills and effort to render the drawings original. According to the respondents, in arriving at the above decision, the Court of Appeal had clearly addressed its I mind to the correct provisions of the CA 1987, particularly s. 7(3)(a).

[96] The respondent contended, the Court of Appeal was correct in making reference to the prior arts documents in the following context; with the existence of the prior arts documents, no effort could have been expended in the creation of the appellant's design drawings to render the same original in copyright law. The design drawings of the appellant were furthermore a substantial reproduction of the other prior arts such as the prototype and Desa Kim Loong machine. Moreover, according to the respondents, the Court of Appeal did not rule that the mere existence of prior arts, would automatically negate the eligibility for copyright protection.

Finding And Analysis On Question 7

[97] We agree with the appellant that the test applicable on the subsistence of the copyright is not "newness" or "novelty". This too seems to be the position taken by the respondents. The different legal test in patent and copyright was explained by the High Court in *Radion Trading Sdn Bhd v. Sin Besteam Equipment Sdn Bhd & Ors* [2010] 6 CLJ 334; [2010] 9 MLJ 648. Clearly deliberated by Azahar Mohamed J (now CJM) in that case, patent and copyright are two distinct fields of intellectual property law. The basis of patent is the novelty of the subject invention and the notion of originality in copyright law is not the same as novelty found in patent law. His Lordship in that case had clarified clearly this legal proposition in the following way:

> It is incorrect to employ the claims in a patent specification to regulate or limit the scope of copyright protection over an artistic work of a device, which may incidentally correlate or form part of the patented invention. (see paragraph 33)

[98] In determining the subsistence of copyright reference has first to be made to s. 7 of the CA 1987. The relevant provisions are as follows:

> 7. Works eligible for copyright.
>
> (1) Subject to this section, the following works shall be eligible for copyright:
>
> (a) literary works;
>
> (b) musical works;
>
> (c) artistic works;
>
> (d) films;
>
> (e) sound recordings; and
>
> (f) broadcasts.
>
> (2) Works shall be protected irrespective of their quality and the purpose for which they were created.
>
> (2A) Copyright protection shall not extend to any idea, procedure, method of operation or mathematical concept as such.

A (3) A literary, musical, or artistic work shall not be eligible for copyright unless:

(a) sufficient effort has been expended to make the work original in character; and

(b) the work has been written down, recorded, or otherwise reduced to material form.

B

(4) A work shall not be ineligible for copyright by reason only that the making of the work, or the doing of any act in relation to the work involves an infringement of copyright in some other work.

C **[99]** Pursuant to s. 7(1) above, "artistic works'' are eligible for copyright. Artistic works are defined in s. 3 to include a "graphic work" which in turn is defined to include any "drawing".

[100] Section 7(3) qualifies further to provide that in order for artistic works to be eligible for copyright, sufficient efforts must have been expended to D make the artistic works, including drawing, original in character and the works must have been reduced to material form. However, the fact that a work is based on the existing work, or parts of the work is lifted from another work will not prevent it from being original as stated in s. 7(4) of the CA 1987.

E **[101]** It can be summed up from the above provisions that, for copyright to subsist, the work must be (i) original; (ii) complies with the requirement as to form; (iii) belongs to one of the categories of protected works; and (iv) complies with the qualifications for copyright. Once these requirements are fulfilled, a work is protected irrespective of quality and the purpose for F which it was created (see Khaw Lake Tee and Tay Pek San, *Khaw on Copyright Law in Malaysia*, (4th edn, Lexis Nexis 2017) p. 33).

[102] The concept of "originality" in copyright was addressed and carefully deliberated in the English case of *University of London Press Ltd v. University Tutorial Press Ltd* [1916] 2 CH 601. Similar concept was adopted by this court G in *Lau Foo Sun v. Government Of Malaysia* [1969] 1 LNS 78; [1974] 1 MLJ 28 and *Dura-Mine Sdn Bhd v. Elster Metering Ltd & Anor* [2015] 1 CLJ 887; [2015] 3 MLJ 1. In *Dura-Mine*, this court had emphasised that it was not a requirement for the expression to be in an original or novel form before a copyright can be said to subsist. The copyright law does not require that a H work should be unprecedented or new in comparison with already existing works.

[103] What we can conclude from the above discourse is that the concept of "newness" or "novelty" in the patent law is not a relevant consideration for copyright to subsist. What is more important is that sufficient efforts have I been expended to render the work original in copyright law as clearly articulated in s. 7(3)(a).

[104] Back to the facts before us, it can be safely concluded therefore that even if the earlier prior arts, particularly the prototype or Desa Kim Loong machine were already in existence before the appellant's design drawings, the appellant's copyright would still subsist and would not be negated by the existence of the earlier prior arts as provided under s. 7(4) of the CA 1987. In the first-place reference to Desa Kim Loong machine has to be rejected, for want of pleading as earlier alluded to in this judgment.

[105] The application of this provision of the law was explained by Associate Professor Dr Tay Pek San in *Intellectual Property Law in Malaysia* (2nd edn, Sweet Maxwell 2020) where it was observed that a creator or author of an original work is entitled to copyright even though he may have infringed the copyright of any work which he has drawn or copied from.

[106] The legal proposition is clear that a work shall not be ineligible for copyright merely by reason that the making of the work involves an infringement of copyright in some earlier or other works. What is essential for a subsistence of copyright in such work is the sufficient effort expended in terms of time, labour and skills to render the same original.

[107] We note that it was the finding of the High Court that the veracity of the content in PW1's statutory declaration was neither challenged nor rebutted by the respondents during the trial, it was on this basis that the learned trial judge supported his findings on the subsistence of copyright of the appellant. This is a finding of fact supported by sound reasons and evidence which the appellate court should not have interfered with.

[108] From its grounds of judgment the Court of Appeal failed to consider this piece of evidence as found and relied upon by the learned trial judge. This evidence supported the finding by the trial judge that the basic test required under s. 7(3)(a) of the CA 1987 had been met by the appellant. In doing so, the Court of Appeal had failed to consider the substantive effort elicited from the evidence of PW1, which substantiated the High Court's finding that the appellant had complied with s. 7(3)(a). Our perusal of the grounds of judgment of the Court of Appeal reveals that this unrebutted evidence found by the High Court had escaped its consideration.

[109] The Court of Appeal had failed to consider or analyse the evidence relied upon by the learned judge when it concluded that the appellant failed to prove that s. 7(3)(a) had been complied. This finding of fact by the trial judge was made after weighing the evidence of PW1 during the trial which appellate intervention is best refrained unless the trial court was plainly wrong.

[110] Hence, we agree with the finding of the learned trial judge that there were substantive efforts made by the appellant to entitle itself to the subsistence of copyright in the appellant's design drawings.

A

Question Of Law And Conclusion

[111] We therefore agree with the appellant that the Question No. 7 posed should be answered in the affirmative. In view of the above finding, it would be incumbent upon this court to deliberate on the consequence and implication of this finding, *viz*: whether there is an infringement of that B copyright. Learned respondents' counsel raised issues and submitted that there was no question of law posed pertaining to infringement of copyright for this court to answer. It was further contended that since there was no appeal to be deliberated by this court on infringement of copyright, the decision of the Court of Appeal that there was no infringement must remain.

C

[112] Having considered the resistance raised by the respondents we are of the view that infringement of copyright in this appeal is consequential to our finding that copyright subsisted in the appellant's design drawings. Without deliberating on the consequence of this finding, it would render such a finding meaningless. It will not result in a proper determination of this D appeal.

[113] In this regard, even though the question of law posed does not relate to infringement of copyright, the issue of infringement is a substantial merit to be dealt along with finding on the copyright subsistence as the copyrighted work is protected from any substantial reproduction or infringement under E s. 13(1).

[114] It is often said a court will not act in vain. No court should delve into making a meaningless order. To render the finding of subsistence of copyright meaningful, it is only appropriate and logical that this court F deliberates on this consequential issue.

[115] This court had already ruled and reminded in *Palm Oil Research And Development Board Malaysia & Anor v. Premium Vegetable Oils Sdn Bhd* [2004] 2 CLJ 265; [2005] 3 MLJ 97 that although leave is granted sparingly, once granted, it is not bound hand and foot to limit itself to the framed issues. The G court may deal with any matter which it considers relevant for the purpose of doing complete justice in accordance with the substantial merits of a particular case.

[116] To recapitulate, the High Court concluded and found infringement of copyright against the respondents. In its grounds of judgment, the High Court H reiterated that the requisite tests to infringement had been met. The High Court, as we have earlier alluded to had concluded there was sufficient objective similarity between the respondents' SK Machines and copyrighted works in Annexure G of the appellant's submission. We note that the High Court had referred to Annexure G which was attached to the appellant's I submission made after trial. As such it is not clear as to which evidence His

Lordship was referring to when he cited Annexure G produced during the submission of the appellant before it. Premised on that Annexure G His Lordship found that there was a causal connection between the appellant's Fruit Bunch Splitter and SK Machines and the said similarities constitute a substantial part of the copyrighted work.

[117] Despite concluding that all the three elements above have been met, we see no further deliberation or analysis being taken by the learned High Court Judge on what are the objective similarities and the substantial reproduction that His Lordship had found. On these two elements, the learned judge simply stated in his judgment that there was sufficient objective similarity between the respondents' SK Machines and the copyrighted works (as set out in Annexure G) without more (see para. 49).

[118] The learned judge did not analyse how the element of copying a substantial part of the copyrighted work had taken place. All that His Lordship had stated in the grounds of judgment was simply that there was sufficient objective similarity between the SK Machines and the appellant's design drawings. His Lordship too did not explain how and why and what were the similarities which constitute a substantial part of the copyrighted work.

[119] On the element of causal connection, the learned trial judge had concluded at para. 48 of his judgment that His Lordship's finding was essentially premised on two main reasons. First, there was accessibility to the design drawings, according to the learned trial judge when the demonstration of the appellant's Fruit Bunch Splitter took place at the first respondent's mill for two days on 24 April 2009 and 25 April 2009. After that demonstration, a quotation was sent by the appellant to the first respondent of its Fruit Bunch Splitter model KH-7. This quotation was said to have provided the breakdown costs for the supply and installation of the machine, together with other relevant machineries at the said premises. The quotation was also found to have consisted specific dimensions and specifications of these machineries. Accordingly, a detailed machinery layout technical drawing dated 22 April 2009 was also sent together with the quotation. This appears to be the other reason cited by His Lordship.

[120] The High Court then noted that, the first respondent however instead of purchasing the Fruit Bunch Splitter from the appellant went on to purchase SK Machine from the second respondent. This took place about a few months later and not long after the said demonstration was held at the first respondent's mill.

[121] To further support the issue on causal connection, the High Court went on to find the respondents' SK Machines' reinforcement bars to be a feature similarly found in the appellant's Fruit Bunch Splitter. As explained by PW1 in his evidence, the reinforcement bars were only introduced by the appellant in 2008, which was after the Kim Loong drawing was created.

[122] The learned trial judge also found the bearing housing in the SK Machines which are embedded within the body frame to be similar to that of the appellant's Fruit Bunch Splitter. This feature is different from Kim Loong drawing because in Kim Loong drawing the bearing housing is located outside the casing.

[123] The Court of Appeal disagreed with the High Court and found no causal connection. The reasons provided by the Court of Appeal are as stated at paras. 270 to 272 of its grounds of judgment. After a careful deliberation, the Court of Appeal found the quotation sent to the respondent was not forwarded with detailed technical drawings as suggested by the High Court. Moreover the drawing that was sent was in fact not the alleged copyrighted works. This was because the technical drawing enclosed with the quotation was a drawing dated 2009, whereas the pleaded design drawings were that of 2004.

[124] On top and above that, the Court of Appeal had analysed and considered the evidence of DW2 who is the creator of the SK Machines. DW2 testified, he was not present during the demonstration. DW2 even admitted that the SK Machines were adapted from Kim Loong drawing which was created on first June 2003. It was against the backdrop of these evidence of other prior arts, that the Kim Loong machine was manufactured by the second respondent in 2003. The Court of Appeal therefore found no causal connection between SK Machines with the appellant's design drawings which were created in 2004.

The Law On Infringement Of Copyright

[125] The infringement of copyright is dealt with in s. 36 read together with s. 13(1) of the CA 1987. Copyright is infringed under s. 36, by any person who does, or causes any other persons to do, without the license of the owner of the copyright an act, the doing of which is controlled by copyright under the Act.

[126] Amongst the acts controlled by copyright law under the Act are stipulated under s. 13(1) which gives the exclusive right against:

> (a) the reproduction in any material form;
>
> ...
>
> (e) the distribution of copies to the public by sale or other transfer of ownership;
>
> ...
>
> of the whole work or a substantial part thereof, either in its original or derivative form provided that:

[127] The three elements required for establishing copyright infringement are set out in the High Court case of *Megnaway Enterprise Sdn Bhd v. Soon Lian Hock (No 2)* [2009] 8 CLJ 130; [2009] 3 MLJ 525. It referred to the three essential elements constituting copyright infringement as set out by the English case of *Purefoy Engineering Co Ltd v. Sykes Boxall & Co Ltd & Ors* [1955] 72 RPC 89.

[128] The learned trial judge in *Megnaway* (*supra*) too referred to the text by Professor Dr Khaw Lake Tee in *Copyright Law in Malaysia* (1st edn, Butterworths Asia 1994) where at paras. 87 to 88, she explains that for purposes of direct infringement, it must be established that:

(i) there is sufficient objective similarity between the original work or a substantial part thereof, and the infringing copy;

(ii) there is a causal connection between the original work and the infringing copy, that is, the infringing copy must have been copied from the original work, whether directly or indirectly; and

(iii) what has been infringed must constitute a substantial part of the original work.

[129] From the above discussions the law on infringement of copyright is clear and well settled. To prove direct infringement of copyright, all the three elements must be present cumulatively. These three elements are; sufficient objective similarity, substantial reproduction of the copyrighted and there must be a causal connection between the two works.

[130] In determining sufficient objective similarity between the two works, Gunn Chit Tuan J in *Longman Malaysia Sdn Bhd v. Pustaka Delta Pelajaran Sdn Bhd* [1986] 1 LNS 84; [1987] 2 MLJ 359 held that besides proving there is objective similarity, there must also be established that the degree of the objective similarity must be substantial. His Lordship went on to explain that the substantiality is required to be established not merely because of the physical amount of reproduction, but more because of the substantial significance of that which was copied. This principle is important to be borne in mind in order to ensure that the particular similarities relied on, are more likely to be the result of copying and not of mere coincidence.

[131] In the appeal before us, the learned trial judge did not undertake to examine and evaluate on evidence, the distinct materials and features of both works in question. By merely stating that the three requirements of infringements were met without any deliberation and explanation, the learned trial judge has not satisfied to sufficiently deliberate whether the SK Machines was a reproduction of the appellant's design drawings.

[132] In this regard, this court is guided by its decision in *Mohd Syamsul Md Yusof & Ors v. Elias Idris* [2019] 7 CLJ 560; [2019] 4 MLJ 788. It was held that it is the duty of the court to examine and evaluate, on evidence, the

A distinct materials and features of both works in question. Only with such examination and evaluation, the court will be able to make a good comparison to determine similarities and differences between the two works. Essential features and other related elements must be decided based on evidence. This is to enable the court to determine whether the similarities
B are substantial or not, in light of the whole features contained in the two works. Such determination can only be done after examining and evaluating all evidence available but not by referring only to the statement of claim and pleadings.

[133] The learned trial judge had failed to adhere to the requirement in
C *Longman* (*supra*). His Lordship failed to examine whether or not even if the copyrighted works were copied, do they amount to a substantial significance of the copyrighted works.

[134] On this issue, we agree with the Court of Appeal that even if there was access to the design drawings as alleged, the quotation sent to the first
D respondent was on 22 April 2009. There was no explanation if indeed the technical drawing sent in 2009 was the same technical drawings of 2004 that formed the basis of the appellant's pleaded case. It also did not help the appellant's case when DW2 on behalf of the respondents testified that the SK Machines were adapted from the Kim Loong drawing which was created in
E 2003. The Court of Appeal further took into account the evidence of DW2 that he was not present at the demonstration to enable him to copy. The High Court did not consider this relevant evidence in its judgment.

[135] The need to prove causal connection between the two works are indispensable as copyright work must be shown to be a *causa sine qua non*
F of the infringing work. As clearly stated by Diplock LJ in *Francis Day & Hunter Ltd And Another v. Bron And Another* [1963] Ch 587, which was referred in the case of *Elsler Metering Limited & Anor v. Damini Corporation Sdn Bhd & Anor* [2012] 1 LNS 959; [2012] MLJU 1753 "If the existence of the copyright work has no causal connection with the production of the
G alleged infringing work (even though the latter be identical with the former) there is no infringement of copyright".

[136] To succeed on a claim on infringement the appellant bears the burden of proving the elements of sufficient objective similarity and causal connection between the two works as outlined. The burden is always on the
H appellant to establish those ingredients by evidence, only then it will give rise to an inference that respondents had copied the appellant's work. The burden on the respondents then is to rebut that inference. The appellant had failed to establish all these three elements cumulatively to succeed on its claim of infringement.

I

[137] On the reasons given, we agree with the Court of Appeal that the appellant had failed to establish that the respondents in fact have access to the appellant's design drawings.

[138] For all the reasons stated above, we agree with the Court of Appeal that the appellant had failed to establish any infringement of the copyright. Though we agree with the learned High Court Judge that copyright subsists in the design drawings of the appellant but no infringement of copyright has been established.

[139] In the result, the appellant's appeal on the claim relating to copyright is also unanimously dismissed. We make no order on costs.